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GUERRY LEONARD GRUNE
784 S VILLIER CT.
VIRGINIA BEACH, VA 23452

EXAMINER

MIZRAHI, DIANE D

ART UNIT PAPER NUMBER

2165

DATE MAILED: 10/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/896,238

Applicant(s)

GRUNE ET AL.

Examiner

DIANE D. MIZRAHI

Art Unit

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>See Continuation Sheet</u> . |

Continuation of Attachment(s) 6). Other: Drawings as filed on 6/29/01 do not contain element numbers. New drawings with element numbers are required. No new matter can be inserted in Applicant's specification.

III. DETAILED ACTION

Examiner's Remarks

The Office Action mailed 12/23/2003, regarding claims 1-11 and the rejection set forth in the 12/23/2003 office action is hereby withdrawn. All previous presented rejections are hereby withdrawn. Examiner regrets that the prior art was not available in the past. See new office action below:

Specification

This is in response to Applicant's substitute specification of August 13, 2003 which has been entered in Applicant's application.

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01. (see page 3, line 2 for example) The entire specification should be checked for embedded hyperlink and/or other form of browser-executable code.

The abstract of the disclosure is objected to because the abstract should be one paragraph. See MPEP § 608.01(b).

Appropriate correction is required.

Claim Rejections - 35 USC 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over John P. Blasko (Pub. No. U.S. Patent# 20020184130 A1 and Blasko hereinafter) in view of Rivette et al. (U.S. Patent# US 5,991,751 B1 and Rivette hereinafter).

Regarding Claim 1, Blasko teaches 1. A computer system for enabling a simultaneous combination of techniques including intelligent searching for problem solving with, (i.e. knowledge database and program modules) [0022] and (i.e. risk evaluation rules) [0042] and valuation of intellectual property (i.e. the value of a patent or group of patents) [0033] and (i.e.

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valuation and patent investment risks) [0043] while providing (i.e. a bar chart of the overall transaction, resource, valuation and patent investment risks ... patent portfolio label) [0043] of said techniques' results regarding said intellectual property in a meaningful manner with a user interface device (i.e. which reads on the means for displaying risk information using a graphical display) [0005] and (i.e. graphically displays the weighted risk information such that the user has a visual indicator of the relative risks associated with a patent asset or a patent prosecution transaction) [0003], said computer system comprising; at least one server computer [0020]; one or more client computers connected to said server computer via a global area network and one or more computer programs executed by one or more server computers [0020]; wherein said computer program further comprises computer instructions for: storing, retrieving, and searching for information regarding said intellectual property corresponding to a technology sector within a technology exchange [0035] in and from a database (storing, retrieving, and searching problem solving solutions related to said intellectual property in and from a database, storing, retrieving, and searching scientific and engineering publications related to said intellectual property in and from a database; allowing for searching, retrieving, and storing into

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and from said database or databases information regarding said intellectual property within said technology exchange (i.e. technology alternatives) [0008], said problem solving database (i.e. (i.e. knowledge database and program modules) [0022] and (i.e. risk evaluation rules) [0042] , and said science and engineering database, resulting in model mapping and valuing said intellectual property according to one or more search criteria specified by a user.

Blasko does not expressly teach model mapping.

Rivette teaches model mapping (i.e. patent mapping module) (Figure 84) see also (i.e. hyperbolic trees) (Figures 178-179).

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Blasko with the teachings of Rivette to include the claimed model mapping with the motivation to illustrate that patents are becoming more and more important to a business's success, especially in today's global economy. Patents can be viewed as a new type of currency in this global economy because they grant the holder with a right to exclude others from making, using, or selling the patented technology. In some industries, product turnover is fairly rapid. However, core technology, product features, and markets change at a much

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slower rate. Accordingly, even in fast-moving industries, patents which cover core technology are very valuable at protecting a company's research and development investment for an extended period of time (col 1, lines 13-23).

Regarding Claim 2, the limitations of this claim is similar in scope to the rejected claim above and is therefore rejected as set forth above. In addition, Basko does not expressly teach answers to queries regarding any aspect of said intellectual property, including real-time determination of a value of said intellectual property; determination of assignee or assignees; determination of any prior art associated with said intellectual property; determination of any inventors associated with said intellectual property; determination of any patents and patent applications associated with the international and U.S. classification of said intellectual property where said property is itself a patent, determination of any past and current uses and users of said intellectual property; prediction by said model mapping of a value, trend, or existence of current intellectual property and prediction by said model mapping of said value, trend or existence of future intellectual property.

Rivette teaches answers to queries regarding any aspect of the intellectual property, including real-time determination of a value of the intellectual property (i.e. search by fields, Fig. 12H; determining license revenue per patent, Fig. 12M) ; determination of assignee or assignees (Fig. 12B, 1201); determination of any prior art associated with the intellectual property (Fig. 12H, 1226); determination of any inventors associated with the intellectual property (Fig. 12D, 1212); determination of any patents and patent applications associated with the international and U.S. classification of the intellectual property where the property is itself a patent (i.e. search class, Fig. 12D, 1211), determination of any past and current uses and users of the intellectual property (i.e. licensee, Fig. 12M); prediction by the model mapping of a value, trend, or existence of current intellectual property and prediction by the model mapping of the value, trend or existence of future intellectual property (i.e. patent aging, financial functions, Col. 22, lines 66-67; Col. 23, lines 1-10).

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Blasko with the teachings of Rivette to include the claimed answers to queries regarding any aspect of said intellectual property, including instantaneous determination of

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a value of said intellectual property; determination of assignee or assignees; determination of any prior art associated with said intellectual property; determination of any inventors associated with said intellectual property; determination of any patents and patent applications associated with the international and U.S. classification of said intellectual property where said property is itself a patent, determination of any past and current uses and users of said intellectual property; prediction by said model mapping of a value, trend, or existence of current intellectual property and prediction by said model mapping of said value, trend or existence of future intellectual property with the motivation to illustrate that patents are becoming more and more important to a business's success, especially in today's global economy. Patents can be viewed as a new type of currency in this global economy because they grant the holder with a right to exclude others from making, using, or selling the patented technology. In some industries, product turnover is fairly rapid. However, core technology, product features, and markets change at a much slower rate. Accordingly, even in fast-moving industries, patents which cover core technology are very valuable at protecting a company's research and development investment for an extended period of time (col 1, lines 13-23).

Regarding Claim 3, Blasko teaches , problem solving with, and valuation of intellectual property, (i.e. knowledge database and program modules) [0022] and (i.e. risk evaluation rules) [0042] and valuation of intellectual property (i.e. the value of a patent or group of patents) [0033] and (i.e. valuation and patent investment risks) [0043] .

Blasko does not expressly teach, wherein any permutation and combination regarding techniques includes intelligent searching for while providing model mapping of said intelligent searching and valuation results is optionally simultaneous and optionally includes a simpler combination of said techniques.

Rivette teaches a system, wherein any permutation and combination regarding techniques includes intelligent searching for (Fig. 53), while providing model mapping (Figure 84) see also (i.e. hyperbolic trees) (Figures 178-179) of the intelligent searching and valuation results is optionally simultaneous and optionally includes a simpler combination of the techniques (i.e. multiple reports displayed simultaneously, Fig. 67. Note the standard Graphical User Interface which allows different reports to be selected either through a tab interface or tiled on the screen simultaneously, a standard feature of the "Window" menu.)

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It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Blasko with the teachings of Rivette to include the claimed wherein any permutation and combination regarding techniques includes intelligent searching for while providing model mapping of said intelligent searching and valuation results is optionally simultaneous and optionally includes a simpler combination of said techniques with the motivation to illustrate that patents are becoming more and more important to a business's success, especially in today's global economy. Patents can be viewed as a new type of currency in this global economy because they grant the holder with a right to exclude others from making, using, or selling the patented technology. In some industries, product turnover is fairly rapid. However, core technology, product features, and markets change at a much slower rate. Accordingly, even in fast-moving industries, patents which cover core technology are very valuable at protecting a company's research and development investment for an extended period of time (col 1, lines 13-23).

Regarding Claim 4, limitations of this claim is similar in scope to the rejected claim above and is therefore rejected as set forth above. In addition, Blasko does not expressly teach

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providing model mapping of said intelligent searching and valuation results is optionally simultaneous and optionally includes a simpler combination whereby only intelligent searching together ... while providing model mapping.

Rivette teaches providing model mapping of the intelligent searching and valuation results is optionally simultaneous and optionally includes a simpler combination whereby only intelligent searching ... providing model mapping is provided (Fig. 70; Fig. 140. Note that the present invention allows concept searching in conjunction with patent aging and licensee searching.)

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Blasko with the teachings of Rivette to include the claimed providing model mapping of said intelligent searching and valuation results is optionally simultaneous and optionally includes a simpler combination whereby only intelligent searching together ... while providing model mapping with the motivation to illustrate that patents are becoming more and more important to a business's success, especially in today's global economy. Patents can be viewed as a new type of currency in this global economy because they grant the holder with a right to exclude others from making, using, or selling the patented

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technology. In some industries, product turnover is fairly rapid. However, core technology, product features, and markets change at a much slower rate. Accordingly, even in fast-moving industries, patents which cover core technology are very valuable at protecting a company's research and development investment for an extended period of time (col 1, lines 13-23).

Regarding Claim 5, limitations of this claim is similar in scope to the rejected claim above and is therefore rejected as set forth above. In addition, Blasko does not expressly teach , wherein a second simpler combination based systems while providing model mapping.

Rivette teaches wherein a second simpler combination based systems while providing model mapping (Figure 84) see also (i.e. hyperbolic trees) (Figures 178-179) see also (Col. 26, lines 29-33).

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Blasko with the teachings of Rivette to include the claimed wherein a second simpler combination based systems while providing model mapping with the motivation to illustrate that patents are becoming more and more important to a business's success, especially in today's global economy.

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Patents can be viewed as a new type of currency in this global economy because they grant the holder with a right to exclude others from making, using, or selling the patented technology. In some industries, product turnover is fairly rapid. However, core technology, product features, and markets change at a much slower rate. Accordingly, even in fast-moving industries, patents which cover core technology are very valuable at protecting a company's research and development investment for an extended period of time (col 1, lines 13-23).

Regarding Claim 6, Blasko teaches a third simpler combination electronic patent searching and results of said searching for specific intellectual property and simultaneous and real-time valuation of said patented intellectual property.

Blasko does not expressly teach model mapping .

Rivette teaches model mapping (i.e. patent mapping module) (Figure 84) see also (i.e. hyperbolic trees) (Figures 178-179).

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Blasko with the teachings of Rivette to include the claimed model mapping with the motivation to illustrate that patents are becoming more and more important to a business's

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success, especially in today's global economy. Patents can be viewed as a new type of currency in this global economy because they grant the holder with a right to exclude others from making, using, or selling the patented technology. In some industries, product turnover is fairly rapid. However, core technology, product features, and markets change at a much slower rate. Accordingly, even in fast-moving industries, patents which cover core technology are very valuable at protecting a company's research and development investment for an extended period of time (col 1, lines 13-23).

Regarding Claim 7, Blasko teaches a fourth simpler combination ... (see Figure 1, #30, #32, #34 and #36).

Blasko does not expressly teach model mapping.

Rivette teaches model mapping (i.e. patent mapping module) (Figure 84) see also (i.e. hyperbolic trees) (Figures 178-179).

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Blasko with the teachings of Rivette to include the claimed model mapping with the motivation to illustrate that patents are becoming more and more important to a business's success, especially in today's global economy. Patents can be

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viewed as a new type of currency in this global economy because they grant the holder with a right to exclude others from making, using, or selling the patented technology. In some industries, product turnover is fairly rapid. However, core technology, product features, and markets change at a much slower rate. Accordingly, even in fast-moving industries, patents which cover core technology are very valuable at protecting a company's research and development investment for an extended period of time (col 1, lines 13-23).

Claim 8 is are rejected under 35 U.S.C. 103(a) as being unpatentable over John P. Blasko (Pub. No. U.S. Patent# 20020184130 A1 and Blasko hereinafter) in view of Reuven Bakalash et al. (US Patent No. 6,408,292 B1) and Bakalash hereinafter).

The teachings of Blasko have been discussed above.

Blasko does not teach topographical features ... including colors, numbers, or symbols ... direction of increasing and decreasing value.

Bakalash teaches topographical features ... including colors, numbers, or symbols ... direction of increasing and

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decreasing value (i.e. geography... dimensions) (col 4, lines 5-29).

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Blasko with the teachings of Bakalash to include the claimed topographical features ... including colors, numbers, or symbols ... direction of increasing and decreasing value with the motivation to enable full-functioned business analysis (Bakalash, col 1, lines 65-67) and to allow knowledge workers to analyze data from a number of different business perspectives and dimensions (Bakalash, col 2, lines 28-29).

Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over of Rivette et al. (U.S. Patent# US 5,991,751 B1 and Rivette hereinafter).

Regarding Claim 9, Rivette teaches a computer implemented method for enabling optional simultaneous and instantaneous or optional simultaneous or optional instantaneous review of data containing files comprising; patents, patent applications, and publications as they appear in an electronic patent shoe or otherwise, science and engineering technology literature pertinent to the patents and patent applications and

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publications from electronic databases (Col. 10, lines 8-14), and problem solving solutions pertinent to the patents and patent applications and publications from electronic databases (i.e. R&D information, Fig. 2, 206), allowing for evaluation of the review and pertinent real-time valuation methods of the patents or patent applications and publications comprising the steps of; (1) causing generation of an electronic patent shoe with optional real-time access to the science and engineering technology literature review, problem solving solutions review, and valuation methods comprising minimally a plurality of patents, and optionally the technology literature, and the problem solving solutions (i.e. document grouping, Fig. 4, 412; Col. 12, lines 43-67; Col. 13, lines 1-24); (2) causing access to a user interface device to distribute, by means of an audio or visual or audiovisual display, in a meaningful manner, at least a list of patents and associated pertinent valuations of the list of patents in real-time fashion and optionally allowing access and subsequent distribution to problem solving solutions and technology literature associated with and pertinent to the list of patents and associated valuations (i.e. user interface, Fig. 67; Fig. 70; Fig. 142); (3) causing, pursuant to a command to view or hear a next file comprising the patents and associated valuations, the problem solving solutions

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and the technology literature, retrieval and audible or visual display of image or text data or both image and text data representative of at least a portion of the next file (Fig. 148, 14806); and (4) causing, pursuant to a command to view or hear a previous file, retrieval and distribution of at least a portion of the previous file (i.e. next arrow, Fig. 148, 14806); (5) allowing a user to scroll back and forth between steps (2) and (3) with no limitations and to provide reports with or without model mapping that capture any desired portion of the visual or audible or audiovisual displays (i.e. back arrow, Fig. 148, 14806).

Regarding Claim 10, Rivette teaches a method comprising sequential steps of (1) causing generation of a problem solving solutions review with optional instant access to the science and engineering technology literature review, the electronic patent shoe, and the valuation methods comprising minimally problem solving solutions, and optionally the technology literature, and a plurality of patents (Col. 13, lines 25-44) and; (2) causing access to a user interface device to distribute, by means of an audio or visual or audiovisual display, in a meaningful manner, at least a list of a problem solving solutions review of patents and associated pertinent valuations of the list of patents in an instantaneous or near instantaneous fashion and optionally

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allowing access and subsequent distribution to problem solving solutions and technology literature associated with and pertinent to the list of patents and associated valuations (i.e. user interface, Fig. 67; Fig. 70; Fig. 142), (3) causing, pursuant to a command to view or hear a next file comprising the solutions, the patents from the electronic patent shoes and the technology literature with the value of the patents retrieved from the electronic patent shoe based on the solutions, retrieval and audible or visual display of image or text data or both image and text data representative of at least a portion of the next file (Fig. 148, 14806); and (4) causing, pursuant to a command to view or hear a previous file, retrieval and distribution of at least a portion of the previous file (i.e. next arrow, Fig. 148, 14806); and;

(5) allowing a user to scroll back and forth between steps (2), (3), and (4) with no limitations and to provide reports with or without model mapping that capture any portion of the visual or audible or audiovisual displays (i.e. back arrow, Fig. 148, 14806).

Regarding Claim 11, Rivette teaches a method comprising sequential steps of (1) causing generation of a valuation of intellectual property with optional instant access to the science and engineering technology literature review, the

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electronic patent shoe, and the problem solving solutions review comprising minimally valuation solutions, and optionally the technology literature review results, electronic patent shoe searching results and problem solving solution results (Col. 13, lines 25-44); (2) causing access to a user interface device to distribute, by means of an audio or visual or audiovisual display, in a meaningful manner, at least a list of associated pertinent valuations of the list of patents, a problem solving solutions review of patents in an instantaneous or near instantaneous fashion and optionally allowing access and subsequent distribution to problem solving solutions and technology literature associated with and pertinent to the list of patents and associated valuations (i.e. user interface, Fig. 67; Fig. 70; Fig. 142); (3) causing, pursuant to a command to view or hear a next file comprising the valuations from the associated patents from the electronic patent shoes, associated problem solving solutions and associated technology literature, retrieval and audible or visual display of image or text data or both image and text data representative of at least a portion of the next file (Fig. 148, 14806); and (4) causing, pursuant to a command to view or hear a previous file, retrieval and distribution of at least a portion of the previous file (i.e. next arrow, Fig. 148, 14806); (5) allowing a user to scroll back

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and forth between steps (2), (3), and (4) with no limitations and to provide reports with or without model mapping that capture any portion of the visual or audible or audiovisual displays (i.e. back arrow, Fig. 148, 14806).

Other Prior Art Made of Record

The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. U.S. patents and U.S. patent application publications will not be supplied with Office actions. Examiners advises the Applicant that the cited U.S. patents and patent application publications are available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site (www.uspto.gov), from the Office of Public Records and from commercial sources. For the use of the Office's PAIR system, Applicants may refer to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diane D. Mizrahi whose telephone number is 571-272-4079. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be

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reached on (571) 272-4146. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 873-8300 for regular communications and (703) 305-3900 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



Diane Mizrahi
Primary Patent Examiner
Technology Center 2100

October 10, 2005